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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,937	02/25/2005	Klaus Biester	1600-11800	4987
45933 7590 09/15/2008 CONLEY ROSE, P.C. 600 TRAVIS SUITE 7100 HOUSTON, TX 77002				
EXAMINER JOYCE, WILLIAM C				
ART UNIT		PAPER NUMBER		
3682				
MAIL DATE		DELIVERY MODE		
09/15/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/525,937

**Applicant(s)**

BIESTER, KLAUS

**Examiner**

William C. Joyce

**Art Unit**

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 July 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.  
4a) Of the above claim(s) 8-12 and 18 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-7, 13-17 and 19 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 9/19/05  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is the First Office Action in response to the Election for the above identified patent application .

#### ***Election/Restrictions***

1. Claims 8-12, and 18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 11, 2008.

#### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-7, 13-17, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - a. Claim 1, line 2, the claim terminology "or the like" and "in particular" is unclear. The metes and bounds of the desired patent protection cannot be determined.
  - b. Claim 4, line 2, the limitation "the worm" lacks proper antecedent basis.
  - c. Claim 4, line 2, the limitation "a drive shaft" is not understood if applicant is referencing one of the "at least two drive shafts" defined in claim 1.

- d. Claim 5, line 2, the limitation "the worm" lacks proper antecedent basis.
- e. Claim 6, the limitation "the drive shaft" is not clear if applicant is referencing both of the "at least two drive shafts" (claim 1) .
- d. Claim 15, last line, claim terminology "or the like" is unclear. The metes and bounds of the desired patent protection cannot be determined.
- e. Claim 17, line 2, the limitation "the gears" lacks proper antecedent basis.
- f. In claim 17, line 2, the term "consisting" is a closed term which limits the inclusion of elements other than those recited by the claim. Examiner suggests changing the term to --comprising--.
- g. Claim 19, the limitation "the mechanical coupling device" lacks proper antecedent basis.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 14-16, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Linzenkirc (DE 3 607 899).

Linzenkirc discloses a drive device, the operating element being actively connected with at least one driving motor (9,9') via a drive train (10,10'), and at least one transmission changing unit being arranged in the drive train for

converting a revolution of the driving motor into a revolution of the operating element, and/or a revolution/linear motion converter being arranged for converting the revolution of the driving motor into a linear motion of the operating element, characterized in that the drive train comprises at least one essentially disk- or wheel-shaped revolution introducing device (12) actively connected with at least two drive shafts (11,11') rotated by separate driving motors.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3, 5, 7, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linzenkirc (DE 3 607 899) in view of Vyskocil (USP 3,998,108).

Linzenkirc does not disclose the gearing device having a worm, however the use of a worm gearing was well known in the art to obtain a desired speed reduction. For example, the prior art to Vyskocil discloses a worm gearing device for a valve arrangement. It would have been obvious to one of ordinary skill in the art to configure the gearing device of Linzenkirc with a worm arrangement, as taught by Vyskocil, motivation being to provide a gear device having a predetermined speed reduction.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linzenkirc (DE 3 607 899).

Linzenkirc does not disclose the gearing device having a position sensor, however it was notoriously known in the art to provide means for determining a position of an actuator. Official Notice is taken with respect to providing a sensor on a driven member of an actuator for determining a position of the actuator output, since it was well known in the art.

***Allowable Subject Matter***

10. Claims 4 and 6 would be allowable if rewritten to clearly define **the at least two drive shafts each have a pair of motors positioned on both ends thereof**, to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. of USP 3168665, 4803390, and 5043617.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Joyce whose telephone number is (571) 272-7107. The examiner can normally be reached on Monday - Thursday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William C. Joyce/ 9/12/08  
Primary Examiner, Art Unit 3682